

**REMARKS**

In the Office Action dated March 22, 2007 (hereinafter, "Office Action"), the Examiner rejected claims 1-42<sup>1</sup> under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2002/0156723 by Lilly et al. (hereinafter, "*Lilly*"); and rejected claims 14, 28, and 42 under 35 U.S.C. § 103(a) as being unpatentable over *Lilly* in view of U.S. Patent Publication No. 2002/0138428 to Spear (hereinafter, "*Spear*").

By this response, Applicants hereby amend claims 1, 14, 15, 28, 29, and 42, and add new claims 43-45. Support for new claims 43-45 may be found in the specification at, for example, paragraphs 037 and 042. Accordingly, claims 1-45 remain pending.

Based on the following remarks, Applicants respectfully traverse the above rejections under 35 U.S.C. §§ 102(e) and 103(a), and respectfully request allowance of claims 1-45.

**I. Rejection Under 35 U.S.C. § 102(e)**

Applicants respectfully traverse the rejection of claims 1-13, 15-27, and 29-41 under 35 U.S.C. § 102(e) as anticipated by *Lilly*. A proper anticipation rejection requires that "each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference." *M.P.E.P.* § 2131. Applicants respectfully submit that *Lilly* fails to disclose all of the subject matter recited in each of amended independent claims 1, 15, and 29.

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<sup>1</sup> Although the Office Action on page 2 states that claims 1-42 are rejected under 35 U.S.C. § 102(e), the subsequent paragraphs provide no detail regarding claims 14, 28, and 42. Instead, page 6 of the Office Action states that claims 14, 28, and 42 are rejected under 35 U.S.C. 103(a). Accordingly, Applicants believe the statement on page 2 is a typographical error and that only claims 1-13, 15-27, and 29-41 are rejected under 35 U.S.C. § 102(e).

Claim 1, for example, has been amended to recite “adjusting one or more fees charged to the financial account for purchase transactions with the selected vendor based on a number of purchase transactions with the selected vendor over a predetermined time period,” as recited in amended claim 1. The Examiner states that “Lilly fails to teach reducing fees charged to the financial account for purchase transactions with the selected vendor based on a number of purchase transactions with the selected vendor over a predetermined period of time.” Office Action, p. 7.

Accordingly, *Lilly* fails to disclose all of the subject matter recited in Applicants’ amended independent claim 1. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e), and allowance of amended independent claim 1, as well as claims 2-14 and 43, which depend from independent claim 1.

To the extent the Examiner asserts claims 1-13, 15-27, and 29-41 are unpatentable in view of *Lilly* under 35 U.S.C. § 103(a), Applicants note (as the Examiner does on page 2 of the Office Action) that *Lilly* and this application have a common assignee. Because the present application and *Lilly* were, at the time the invention was made, owned by, or subject to an obligation of assignment to Capital One Financial Corporation<sup>2</sup>, *Lilly* is not available as prior art for the purpose of 35 U.S.C. § 103(a). See 35 U.S.C. § 103(c).<sup>3</sup>

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<sup>2</sup> Assignment recordation information for U.S. Patent Application Serial No. 09/987,952 may be found at Reel 012521/Frame 0927. Assignment recordation information for *Lilly* may be found at Reel 011721/Frame 0006.

<sup>3</sup> An applicant can establish common ownership of an application and a reference with a statement by the applicant or any attorney or agent of record to the effect that the application and the reference were, at the time of the invention was made, owned by, or subject to an obligation of assignment to, the same person. See *M.P.E.P.* 706.02(l)(2).

Amended independent claims 15 and 29, although of differing scope, recite elements similar to those of amended independent claim 1, and are therefore allowable for at least the same reasons. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e), and allowance of independent claims 15 and 29. Claims 16-28 and 44 depend from independent claim 15, and claims 30-42 and 45 depend from independent claim 29. Accordingly, claims 16-28, 30-42, 44, and 45 are allowable at least due to their dependence from their corresponding allowable independent claims.

## **II. Rejection Under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims under 35 U.S.C. §103(a) as being obvious over the cited art. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *M.P.E.P.* § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” *USPTO Memorandum* from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, p. 2. A *prima facie* case of obviousness has not been established because, among other things, none of the cited art nor any obvious variant thereof, taken alone or in any reasonable combination, teaches or suggests each and every element of Applicants’ claims.

As noted above, *Lilly* and this application have a common assignee. Accordingly, *Lilly* is not available as prior art for purposes of 35 U.S.C. § 103(a).

Moreover, *Spear* fails to teach or suggest every recitation of claim 1. For example, *Spear* fails to teach or suggest, *inter alia*, "providing a consumer with the financial account having a first account component and a second account component, wherein the first and second account components have respective first and second account parameters associated with purchase transactions made by the consumer using the financial account" and "allowing the consumer to select a vendor to be associated with the first account component," as recited in amended claim 1. Indeed, the Examiner does not rely on *Spear* for these teachings.

Accordingly, because *Lilly* is not available as prior art, and *Spear* fails to teach or suggest each and every claim recitation of independent claim 1, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and allowance of amended independent claim 1, as well as claims 2-14 and 43, which depend from claim 1.

Amended independent claims 15 and 29, although of differing scope, include recitations similar to those of amended independent claim 1, and are therefore allowable for at least the same reasons set forth above. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and request allowance of amended independent claims 15 and 29. Claims 16-28 and 44 depend from independent claim 15, and claims 30-42 and 45 depend from independent claim 29. As explained above, the cited art does not support the rejection of claims 15 and 29. Therefore, dependent claims 16-28, 30-42, 44, and 45 are

allowable for at least the same reasons set forth above in connection with claims 15 and 29.

**III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

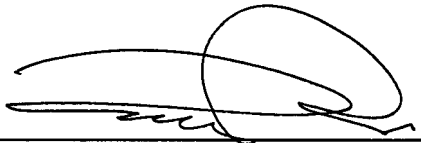
The Office Action contains a number of statements reflecting characterizations of the claims. Regardless of whether any such statement is identified herein, Applicants do not automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,  
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By: \_\_\_\_\_

  
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